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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/830,476 | 10/30/2001 | Gilbert Moineau | SWA-002-US | 8087 |
| 7590 | 07/08/2005 | | EXAMINER | |
| Piper Marbury Rudnick & Wolfe 1200 Nineteenth Street NW Washington, DC 20036-2412 | | | REFAI, RAMSEY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2152 | |

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|----------------|--|
| Application No. | Applicant(s) | |
| 09/830,476 | MOINEAU ET AL. | |
| Examiner | Art Unit | |
| Ramsey Refai | 2152 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 May 2005.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) 11 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-10, 12-21 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Amendment received on May 17, 2005. Claims 3-5, 7-9, 15, 17, and 19 have been amended. Claim 11 has been canceled. Claims 1-10 and 12-21 are now presented for examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-10 and 12-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhatia et al (U.S. Patent No. 6,023,724).

3. As per claim 1, Bhatia et al teach a network modem device configuration system connected to a modem via a local network, the system comprising
a first module sending a request on said local network to said modem to obtain identification and static IP address data from said modem (**see column 24, lines 51-59, column 36, lines 15-60; workstation inquires address of modem**),

Art Unit: 2152

a second module receiving a response from said modem and displaying said static IP address (**see column 4, line 45-column 5, line 10, column 36, lines 15-60; user interface displays network configuration data**).

a third module accepting user input to set said static IP address (**see column 4, line 45-column 5, line 10, column 37, lines 57-65; user can configure modem**) , and

a fourth module sending a request on said local network to said modem to set said static IP address (**see column 24, line 44-column 25, line 9, column 38, lines 1-29; modem stores IP address**).

4. As per claim 2, Bhatia et al teach a fifth module testing said static address on said network and, when said testing fails to validate operation of said static address for said modem, preventing said fourth module from sending the request on said local network to said modem to set said static IP address, and one of displaying an error message and prompting said user to input new data for said static address (**see column 38, lines 1-29, column 4, line 45-column 5, line 10, column 18, lines 28-36, column 36, lines 3-6, column 37, line 3-18, and column 48, lines 15-55**).

5. As per claim 3, Bhatia et al teach said first module sends a broadcast discover message on said local network to said modem to solicit a response identifying said modem, said second module receiving and decoding a response from said modem to obtain said identification and static IP address, and said fourth module broadcasts on said local network to said modem a

message including said Identification of said modem and an identification of said set static address (**see column 36, line 12-column 37, line 40, column 24, line 15-column 25, line 4**).

6. As per claim 4, Bhatia et al teach said broadcast message sent by said first and fourth modules, and received by said second module is transmitted on a proprietary port (**see column 40, lines 34-40**).

7. As per claim 5, Bhatia et al teach a parameter setting interface system allowing modem parameters to be set at said configuration system (**see column 35, lines 60-62, column 5, lines 1-10**).

8. As per claim 6, Bhatia et al teach said parameter setting interface system includes a save and restore mechanism allowing said modem parameters to be saved In storage external from said modem and restored to said modem from said storage (**see column 35, lines 1-10, column 35, lines 29-46**).

9. As per claim 7, Bhatia et al teach said parameter setting interface system is provided by a web browser displaying pages requested from said modem, said system further comprising a sixth module for launching said web browser with an HTTP request addressed to said static address (**see column 35, lines 60-62, column 5, line 1-10**).

10. As per claim 8, Bhatia et al teach said modem is an ISDN modem, said modem parameters are selected from said group consisting of DHCP configuration settings, DNS settings, and ISDN connection settings (**see abstract, column 6, lines 7-14, column 35, line 54-65**).

11. As per claim 9, Bhatia et al teach a seventh module allowing a network configuration of said station to be set in consideration of changes to said local network due to an addition of said modem to said local network (**see column 36, line 1-11; new modem**).

12. As per claim 10, the claim contains similar limitations as claims 1-9 above, therefore it is rejected under the same rationale.

13. As per claim 12, Bhatia et al teach a method for initializing a static IP address of a network modem device on a local network, comprising the steps of:

broadcasting a request from a configuration station onto said local network (**see column 24, lines 51-59, column 36, lines 12-35; workstation inquires address of modem**);
receiving a response to said request at said configuration station from said network modem device comprising an identification for said network modem device, said identification comprising at least an IP address for said network modem device (**see column 24, lines 15-67, column 35, line 15-60**);

verifying a compatibility of said Identification with settings for said local network (**see column 4, line 35 – column 5, lines 10, column 38, lines 1-29**);

if said identification is compatible with said settings, send a confirmation message with said identification to said network modem device and receive a confirmation response from said network modem device (**see column 48, lines 15-55 and column 18, lines 20-41, column 38, lines 1-29**);

if said identification is not compatible with said settings, send a new address message comprising a new IP address for said network modem device, receive a change of IP response from said network modem device, send a new address confirmation message with said new IP address to said network modem device and receive a new address confirmation response from said network modem device (**see column 18, lines 20-41 and column 24, lines 15-59, column 38, lines 1-29**).

14. As per claim 13, Bhatia et al teach said request by said configuration station comprises a broadcast message, and said Identification comprises an IP address, a MAC address and an internal DHCP server status for said network modem device (**see column 36, line 15-60, column 5, lines 15-35, column 12, lines 44-65**).

15. As per claim 14, Bhatia et al teach said messages from said configuration station and said responses from said modem are sent on a proprietary port (**see column 40, lines 34-40, column 5, lines 15-35, column 12, lines 44-65**).

Art Unit: 2152

16. As per claim 15, Bhatia et al teach said modem further comprises an integrated DHCP server, and said message sent from said modem further includes an activation status of said DHCP server (**see column 36, lines 47—50, column 6, lines 9-14**).

17. As per claim 16, Bhatia et al teach said modem automatically detects a presence of a network DHCP server on said local network and disables said Integrated DHCP server when a network DHCP server is present on said local network (**see column 49, lines 30-40, column 43, line 42-column 44, line 18, column 6, lines 9-48**)..

18. As per claim 17, Bhatia et al teach said device is a digital network modem (**see abstract**).

19. As per claim 18, Bhatia et al teach said device is an ISDN modem (**see abstract**).

20. As per claim 19, Bhatia et al teach a parameter setting interface system allowing modem parameters to be set by remote connection via said local network (**see column 35, lines 60-62, column 5, lines 1-10**).

21. As per claim 20, Bhatia et al teach said interface system is provided by a web host mechanism (**see column 35, lines 60-62, column 5, lines 1-10**).

22. As per claim 21, Bhatia et al said web host mechanism provides for saving said modem parameters to, and restoring said modem parameters from, said remote connection (**see column 35, lines 1-10, column 35, lines 29-46**).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, applicant argues in substance that:
 - a. Bhatia does not teach sending a request to a modem to obtain identification and static IP address from said modem;
 - b. Bhatia does not teach the modem sending a request to the workstation to set a static IP address;
 - c. Bhatia does not teach testing and setting a static IP address for a modem;
 - d. Bhatia does not teach broadcasting to obtain a static address from a modem and set the static IP address for the modem.
- In reply to argument:
 - a. Examiner respectfully disagrees because Bhatia teaches a user that can configure a LAN modem using a web page displayed in a browser. The user send request to obtain LAN modem information, such as the LAN modem's IP address. (**see column 35, line 54-column 11, column 5, lines 1-10**).
 - b. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the modem sending a request to the workstation to set a static IP address) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- c. Examiner respectfully disagrees because Bhatia teaches that an IP address is verified before setting an IP address for the modem. The IP address is broadcasted to other network entities on the LAN in order to elicit a response from any other network entity having that IP address. (**see column 38, lines 1-29**).
- d. Examiner respectfully disagrees because Bhatia teaches broadcasting a message to obtain modem information; such as the IP address in order to reconfigure the modem and set an IP address for the modem using a webpage displayed in a browser. (**see column 5, lines 1-10, column 35, line 53-column 36, line 60**).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2152

RR
July 1, 2005